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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,763	10/04/2006	Emile Lopez	0540-1063	4673
466 7590 12/22/2010 YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314			EXAMINER JANCA, ANDREW JOSEPH	
			ART UNIT 1774	PAPER NUMBER
			NOTIFICATION DATE 12/22/2010	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary

Application No.

10/588,763

Applicant(s)

LOPEZ, EMILE

Examiner

Andrew Janca

Art Unit

1774

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5, 7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 7 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-945)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 10/26/10 have been fully considered but regarding the art rejections over Birdseye (Remarks 10/26/10 pp 4-6) they are not persuasive. The amendments to claim 5 overcome the 102 rejections over Murray (Remarks p 6), but do not exclude Birdseye from their scope.
2. The first chamber of Birdseye has means for heating of the radiant type 16 (figure 1) which are substantially identical in structure to the disclosed means for heating of the radiant type 16 in Applicant's specification (figure 1). None of the other "means for" limitations have any further description or illustration of corresponding structure in Applicant's disclosure. However, Birdseye further discloses mechanical transfer means 20, 30 (figure 1) which are also substantially identical in structure to Applicant's disclosed mechanical transfer means 12 (figure 1). Birdseye further explicitly teaches that the infrared heating lamps are capable of heating the chambers through which the mechanical transfer means passes to temperatures ranging from 200 F to as high as 350 F, or 143 C to 226 C (8:55-61). Birdseye's apparatus may be designed to heat and dry particulate or granular vegetables or vegetable pieces, but it is equally capable of heating worn road materials which may be viscous. As the means for agglutinating road coatings at the outlet of the first chamber are nowhere described in any detail or even depicted in Applicant's figures—all that is depicted is something resembling a funnel for directing what appears to be entirely un-agglutinated particulate

material (figure 1)--any conceivable means which might agglutinate granules of heated viscous road materials would fit the limitations of the claim. The means 22-27 Birdseye discloses to transfer dried particulate materials from one heating chamber to another would have a substantially greater agglutinating effect than Applicant's straightforward funnel, as the conveyed materials are transported through a pair of opposing rollers with a tight gap between them: though these may scatter dry particulate materials, they would tend to agglutinate sticky viscous particles passed and squeezed through them (Birdseye figure 1). Birdseye's disclosed apparatus is not only structurally similar to Applicant's disclosed apparatus, but it would seem to be capable of doing the job of Applicant's *claimed* apparatus as well if not better than Applicant's disclosed apparatus. It has been held that the recitation of a new intended use, for an old product, does not make a claim to that old product patentable. See *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5, 7, and 9 are rejected under 35 USC 102(b) as anticipated by US 2,419,876 to Birdseye.

5. With regard to claim 5, Birdseye discloses a device capable of heating a material constituted at least in part by worn road coatings to be recycled, comprising a first chamber 12-20 (chambers referred to by floor and ceiling part numbers) provided with mechanical transfer means 20, means for heating 16 of the radiant type that is arranged to cause solid materials which may be worn road coatings to be recycled if desired to reach a first temperature between 105 and 130 degrees C, a temperature which would render bitumen therein viscous, and means 71 for evacuating gaseous effluents; a second chamber 29-30 provided with mechanical transfer means 30, means for heating 16 of the radiant type which are arranged to cause worn road coatings from said first chamber to reach a second temperature between 160 and 220 degrees C, and means 26-36-71 for evacuation of gaseous effluents from the second chamber; and means for agglutinating the worn road coatings to be recycled, constricted passage 22-27, disposed at the outlet of the first chamber (figure 1; 2:49-50, 6:1ff). It has been held that "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim," see *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969); and that the manner of operating an apparatus does not differentiate an apparatus claim from the prior art, if the prior art apparatus teaches all of the structural limitations of the claim: see *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987).

6. The additional elements of claim 7, including a that each of the first and second chambers 12-20, 29-30 comprises a substantially parallelepipedal chamber 12-20, 29-30, and that that the mechanical transfer means in each of the first and second

chambers comprise inclined and/or horizontal conveyors 20, 30 provided with means for vibrating 81 (raised portions under the conveyor belt will shake its contents), and that said means for heating 16 of the radiant type comprises panels 82, are taught by Birdseye (figures 1, 8-9; 9:35ff).

7. The additional elements of claim 9, including means 70-46 for treating the gaseous effluents emitted from the second chamber including composition catalysts, are taught by Birdseye (figure 1; 7:59-8:1). Composition catalysts may be introduced into the gaseous stream if desired. It has been held that "[e]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining the patentability of the apparatus claim." See *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **this action is made final**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Janca whose telephone number is (571) 270-5550. The examiner can normally be reached on M-Th 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on (571) 272-1447. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AJJ

/DAVID L. SORKIN/
Primary Examiner, Art Unit 1774